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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,757

04/14/2004

Didier Frantz

02-005

5062

50524

7590

08/11/2006

SCANBUY, INC.
54 WEST 39TH STREET
FOURTH FLOOR
NEW YORK, NY 10018

EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/823,757	FRANTZ ET AL.	
	Examiner	Art Unit	
	Adam Levine	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,9 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,9 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' reply dated May 30, 2006, was filed in response to the requirement for election/restriction mailed March 6, 2006. Applicants have elected the species of claims 1,5, and 9. Claims 2-4, 6-8, and 10-15 have been cancelled and claims 16-18 have been newly added. Claims 1,5,9, and 16-18 are examined in this office action.

Election/Restrictions

Applicant's election without traverse of claims 1,5, and 9, in the reply filed on May 30, 2006, is acknowledged. Claims 2-4,6-8, and 10-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Claims 2-4,6-8, and 10-15 have further been cancelled.

Double Patenting

1. Claims 1,5, and 9 of this application conflict with claims 1,5, and 9 of Application No. 10/823,756. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

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discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1,5, and 9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of copending Application No. 10/823,756. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) may be required in this application because:

- Figure 3 may have been intended as another figure. There are two uploading steps in figure 2 but the description of figure 3 only refers to "the uploading step."
- The detailed description of the drawings does not conform with the brief description.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

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Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Specification

The disclosure is objected to because of the following informalities: Figures 2A and 2B are missing from the brief description and the detailed description of the drawings does not conform with the brief description. Please see the objections to the drawings. The problems with the drawings may be rooted in the descriptions in the specification.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 5, and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps between scanning codes with the scanner and transmitting the stored codes to a computer, i.e., the storing steps.

Claim 1 recites the limitations "each client and each vendor" in line 7, "the owner of the shopping cart" in line 8, and "said designated vendor" in line 13. There is insufficient antecedent basis for these limitations in the claim.

Regarding claim 5, the phrase "creating a first vendor shopping list for said first client by placing all product machine readable codes found in a first preferred vendor database to said first vendor shopping list" renders the claim indefinite because it is unclear that the product machine readable codes placed to said first vendor shopping list are the codes previously scanned and assigned to a different vendor shopping list for each client. In other words, claim 5 appears to be adding all of the product machine readable codes in the vendor database to the shopping list, rather than only adding the ones that have previously been scanned and assigned. The first above described interpretation will be followed in examining the claim.

Claims 16-18 are indefinite and fail to particularly point out and distinctly claim the subject matter that applicants' regard as the invention because the claims are directed to a system but are dependent on claims drawn to a method. It cannot therefore be determined whether applicants' are claiming a system or a method. See rejection under 35 USC 101.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In these claims, applicant is claiming both a system and a method in the same claims. The invention of claims 16-18 therefore either falls somewhere in between two statutory classes, or attempts to claim two different statutory classes in the same invention. Because the statute uses the exclusive "or" in listing the classes of invention, indicating that the invention must fall clearly within one of the classes, the claims must therefore be rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,5, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Covington (US Pub. No.2003/0154135).

Covington teaches

1. A method for aggregating and managing client orders comprising the steps of:

- scanning at least one client machine readable code with a scanner (see at least page 15 para.0168);
- scanning at least one product machine readable code with said scanner (see at least page 13 para.0150,0158,0174);
- transmitting said codes stored in said scanner to a computer (see at least abstract, page 2 para.0016-0017);
- creating a shopping list for each client and each vendor; by using said client machine readable code to identify the owner of the shopping cart and by using a predetermined vendor preference list stored on said computer to assign each product machine readable code to a different vendor shopping list for each client (see at least page 18 para.0187); identifying the first client machine readable code from said uploaded information (see at least page 10 paras.0123-0124, page 15 para.0168, pages 16-17 para.0176); creating a first vendor shopping list for said first client by placing all product machine readable codes found in a first preferred vendor database to said first vendor shopping list (see at least page 4

para.0071, page 18 para.0187; creating additional shopping lists for each vendor for said first client by utilizing a plurality of preferred vendor databases in an assigned order (see at least pages 7-8 paras.0101-0102, pages 9-10 para.0117, page 19 para.0200); and creating shopping lists in the same manner for each additional client (see at least page 4 para.0071, page 18 para.0187. Please note: It has been held that mere duplication of parts involves only routine skill in the art); wherein said machine readable codes are barcodes, scanner is laser-based, scanner uses optical decoding techniques to scan said barcodes (see at least page 9 para.0016, pages 13-14 para.0150-0158)

- transmitting said shopping lists to the appropriate e-commerce website:
operated by said designated vendor for each client (see at least page 9 paras.0110-0112, page 10 paras.0120-0125, page 19 para.0197);
- completing the aggregate ordering for each client: by placing the order for each client using each of said e-commerce websites (see at least figs 21, page 4 para.0069, page 11 paras.0129-0131, page 19 paras.0196-200).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fitzpatrick; US Pub.No.2002/0069115 (June 6, 2002). Teaches method, system, and computer program for online shopping including a global retailer database, selecting retailers based on location preference, using a list of items and a

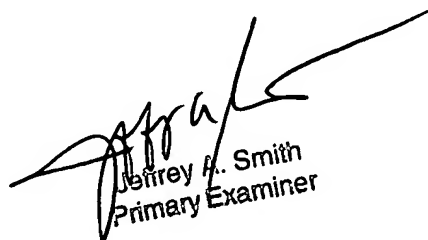
shopping basket of selected items determined from the list of retailers, and a list of items to be purchased that can optionally be direct ordered online from each retailer confirmed to sell the item.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
August 6, 2006



Jeffrey A. Smith
Primary Examiner